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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,054	01/26/2001	Richard A. Mallo	56147USA8A.002	7236

7590 11/30/2004

Attention: Yen Tong Florczak  
Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/771,054

### Applicant(s)

MALLO ET AL.

### Examiner

Blessing M. Fubara

### Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13,14 and 29-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13,14 and 29-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Examiner acknowledges receipt of request for continued examination, amendment and remarks filed 09/15/04.

Pending claims 13, 14 and 29-41 are directed to an invention that is independent or distinct from the invention originally claimed. The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in MPEP § 821.03. However, a shift is permitted in this case, see MPEP § 819.01.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 09/15/04 has been entered.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 13, 14 and 29-41 are rejected under 35 U.S.C. 101 because the asserted utility, which is that the composition in the method of using a cosmetic article “does not have a reshaping effect” is inconsistent with known utility of the composition claimed and disclosed by Rollat et al., US 6,520,186 B2. In US 6,520,186, the same composition is applied to hair to reshape the hair (claims 80-87 and at least claims 1, 10, 11, 23-74; and the whole document). In re Citron, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963). The question is whether an aspect of the instant invention that is necessary to impart the property inconsistent with Rollat is present or absent in the instant invention. In re Sichert, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977). See Fregeau v. Mossinghoff, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985); Newman v. Quigg, 877 F.2d 1575, 11 USPQ2d 1340 (Fed. Cir. 1989); In re Houghton, 433 F.2d 820, 167 USPQ 687 (CCPA 1970); In re Swartz, 232 F.3d 862, 56 USPQ2d 1703, (Fed. Cir. 2000); In re Ruskin, 354 F.2d 395, 148 USPQ 221 (CCPA 1966); In re Citron, 325 F.2d 248, 139 USPQ 516 (CCPA 1963); In re Eltgroth, 419 F.2d 918, 164 USPQ 221 (CCPA 1970); In re Ferens, 417 F.2d 1072, 163 USPQ 609 (CCPA 1969).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 13, 14 and 29-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not

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described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The issues are:

1. The breadth of the claim is that a silylated polyurethane-urea containing composition is provided to the hair and the composition does not have a reshapable effect. However, it is known that the same silylated polyurethane-urea composition is disclosed and used by Rollat et al. (US 6,520,186) to reshape hair. The question is the aspect of the instant invention that allows the instant composition to not reshape the hair is not claimed or disclosed. It would require undue experimentation for the person of ordinary skill to practice the invention so that the composition performs a function that is inconsistent with Rollat.
2. The nature of the invention is a cosmetic where a composition is applied to the hair. The instant composition is also a composition of Rollat where Rollat applies the composition to hair to reshape the hair. But in the instant case, said composition does reshape the hair. It would require undue experimentation for a person of ordinary skill in the art to ascertain the aspect of the composition that affords different properties between the instant composition and the composition of Rollat and to arrive at one that when applied to hair would not reshape the hair.
3. The amount of guidance provided in the instant specification is limited to the preparation of the compositions and does not provide working examples on the silylated polyurethane-urea composition does not reshape the hair when the composition is applied to the hair.

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***Claim Objections***


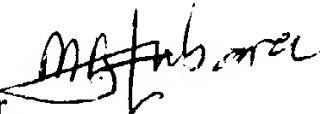
Claims 13 and 14 depend on subsequent claim. A dependent claim should depend on preceding claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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